



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/743,836   | 12/24/2003  | Hirokazu Sakai       | 247085US0           | 1132             |
| 22850  | 7590        | 03/28/2008           |                     |                  |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| VENKAT, JYOTHSNA A   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1615   |             |                      |                     |                  |
| NOTIFICATION DATE  |             | DELIVERY MODE        |                     |                  |
| 03/28/2008   |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

### Office Action Summary

**Application No.**

10/743,836

**Applicant(s)**

SAKAI ET AL.

**Examiner**

JYOTHSNA A. VENKAT Ph. D

**Art Unit**

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt is acknowledged of amendment, remarks, certified copy of foreign translated document filed on 11/14/07. Receipt is also acknowledged of declaration and supplemental remarks filed 12/3/07. Claims 10-21 have been added as per applicants' amendment dated 11/14/07. Claims 1-21 are pending in the application and the status of the application is as follows.

In view of the certified foreign translated document, the 103 rejection over commonly owned PGPUB documents are hereby withdrawn.

Newly added claims 10-20 are obvious over the combination of patents '953 and '705.

#### ***Claim Rejections - 35 USC § 103***

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being obvious over U. S. Patent 6,685,953 ('953) and combined with U. S. patent 5,876,705 ('705).

*The instant application is claiming hair cleansing composition comprising:*

- 1. Amphipathic amide lipid of formula 1*
- 2. Anionic surfactant*
- 3. Organic or inorganic acid*
- 4. Silicone derivatives or cationic polymers (claim 5)*
- 5. Nonionic or amphoteric surfactant (claim 6)*

In patent '953, see the abstract, and see col.s 3-4 for elected species (formula F). Patent at col.7, ll 30-36 suggests surfactants and pH regulators can be added to compositions. Patent at same column, ll 40-44 teaches hair care applications and this includes shampoo. Patent under

example 3 teaches shampoo and this includes the pH adjusting agent citric acid, belonging to belonging to organic acid of claim 1 or hydroxy carboxylic acid of claim 4.

Patent '705 teaches conditioning shampoo compositions. See the abstract; see col.2, ll 25-30 for anionic, amphoteric and non-ionic surfactant. See col.s 4-5 and col.6, ll 1-34 for anionic surfactant. The species taught by patent at col.6, ll 1-34 belong to different class of anionic surfactant claimed in claim 3. See col.6, ll 35-68 and col.s 7-8 and col.9, ll 1-6 for amphoteric surfactant, see col.9, ll 8-68 and col.10, ll 1-14 for non ionic surfactant, see col.12, ll 10-68 for hair conditioning agent. This includes claimed silicone at col.12, ll 40-68 and col.s 13-16. *See col.13, lines 1-35. This includes dimethyl polysiloxane, methylphenylpolysiloxanes. Patent at col.14, ll 1-10 teaches amino modified silicones and these polymers are claimed in new claim 18.* See col.17, ll 7-68, and col. 8 and col.19, ll 1-27 for cationic polymers. *See col.18, ll 30-50 for specific cationic polymers and these are claimed in claim 19.* See paragraph bridging col.s 22-23 for acids and this includes phosphoric acid, citric acid, succinic acid (pH adjusting agents).

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the compositions of patent '953 and combine with agents that are conventionally used in hair care like surfactants and acids and silicone derivatives or cationic polymers taught by patent '705 expecting beneficial effect to hair. One of ordinary skill in the art would be motivated to add the ingredients of '705 with the reasonable expectation of success that the compositions which has the diamide provide moisturizing feel and silkiness to the hair and adding cationic polymers and silicone derivatives provide conditioning property to the hair and adding surfactant provide cleansing actions. Thus the compositions not only cleanse the hair but

Art Unit: 1615

also provide moisturizing and conditioning properties to the hair. This is a prima facie case of obviousness.

***Response to Arguments***

1. Applicant's arguments filed 11/14/07 have been fully considered but they are not persuasive.

Applicants' argue:

*"The examiner cites to the disclosure of Hoshino et al. at column 7 of a pH regulator which could be used in a shampoo composition containing an amphipathic amide lipid as claimed. However, the reference fails to disclose or suggest the specific pH of from 1-4.5 as claimed. Moreover, there is no specific pH regulator disclosed in the passages of this reference cited by the examiner. As such the reference can not suggest the claimed pH range of from 1 to 4.5 as claimed. Applicants respectfully submit that the mere disclosure of a pH regulator fails to disclose or suggest the specific pH of 1-4.5 as claimed, and that even an acidic pH regulator does not suggest the claimed pH of 1-4.5. A pH regulator is merely used to adjust the pH of a composition. Acidic pH regulators lowering the pH, while basic pH regulators increasing the pH. There is no suggestion that the ultimate pH of the composition be either acidic or basic based on the mere disclosure of pH regulators. Further, the pH of a composition will be typically be dependent on the concentration of pH regulator used. The attached passages from the 56th edition of the Handbook of Chemistry and Physics provides evidence on page D-135 that sulfuric acid, a suitable inorganic acid as described on page 17 of Applicants' specification, could have a pH ranging from 0.3-2.1 depending on the concentration of acid. More specifically, a 1*

*normal solution would have a pH of 0.3 while a 0.01 normal solution would have a pH of 2.1. As such, it is clear that an acidic pH adjusting agent does not suggest the claimed range of 1-4.5. As the reference fails to disclose or suggest the claimed pH range of 1-4.5 or even an acidic pH regulator, the claimed invention is clearly not rendered obvious by this reference."*

In response to the above argument, patent '953 teaches pH regulators and under example 3 teaches citric acid. Applicants' are using the same citric acid for controlling the pH. See table 1 of instant specification. With respect to specific pH claimed in the instant application and not taught by patent '953, one skilled in the art would adjust the concentration of citric acid in order to arrive at the claimed pH.

Applicants' also argue:

*"The secondary reference of Uchiyama et al. fails to cure the basic deficiencies of the primary reference. This reference fails to disclose or suggest a pH of 1-4.5 and as such cannot render the claimed invention obvious in combination with Hoshino et al. The examiner cites to the paragraph bridging columns 22-23 which cites the use of pH adjusting agents such as citric acid, succinic acid, phosphoric acid, sodium hydroxide and sodium carbonate. Such a laundry list of pH adjusting agents of an acidic and a basic nature makes clear the failure of the reference to suggest an acidic pH of from 1-4.5."*

In response to the above argument, patent'705 also suggests pH adjusting agents and adjusting the pH to 1-4.5 is within the ken of the skilled chemist since one can adjust the pH by changing the concentration of the pH adjusting agents.

The following new ground of rejection is necessitated by the amendment.

***Claim Rejections - 35 USC § 103***

2. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patent 6,685,953 ('953) and U. S. patent 5,876,705 ('705) as applied to claim 1-20 above, and further in view of U. S. Patent 5,393,519 ('519).
3. Patents '953 and '705 do not teach the limitation claimed in new claim 20. However patent '519 teaches shampoo compositions using claimed surfactant, claimed conditioning agent and claimed acids of claim 21. See anionic surfactant at col.8, ll 1-55. Patent at paragraph bridging col.s 8-9 teaches amphoteric surfactant and teaches nonionic surfactant at col.9, ll 4-32. See col.9, ll 33-55 for the concentration of surfactant. Patent at col.10, line 15 through col.11, line 32 teaches claimed silicone conditioning agents. See col.17, ll 1-5 for pH. Patent teaches that sufficient of acid can added so that final pH can be about 3 to about 8. See examples for lactic acid, phosphoric acid.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the compositions of patent '953 and combine with agents that are conventionally used in hair care like surfactants and acids and silicone derivatives or cationic polymers taught by patent '705 and add lactic acid or phosphoric acid into the compositions of '705 so that pH can be adjusted taught by patent '519. One of ordinary skill in the art would be motivated to add the ingredients of '705 with the reasonable expectation of success that the compositions which has the diamide provide moisturizing feel and silkiness to the hair and adding cationic polymers and silicone derivatives provide conditioning property to the hair and adding surfactant provide cleansing actions. Thus the compositions not only cleanse the hair but

also provide moisturizing and conditioning properties to the hair. This is a prima facie case of obviousness.

***Response to Amendment***

4. The affidavit under 37 CFR 1.132 filed 12/3/07 is insufficient to overcome the rejection of claims 1-9 based upon the combination of U. S. Patent '953 and '705 as set forth in the last Office action because:
5. The declaration is not commensurate with the scope of claims.
6. Acids tested in the affidavit are specific to 4 acids. The weight percent is 0.2% for lactic acid and malic acid and 0.8% for phosphoric acid, glutamic acid and glycolic acid. Claimed weight percent of component C, which is organic or inorganic acid is 0.05% to 10%. There is no test data when the acid weight percent is at 0.05%, 10%.
7. The same is true for surfactant. The data showed results for one anionic surfactant and one nonionic surfactant. There is no data for all the anionic surfactant and amphoteric and nonionic surfactant claimed in the instant application.
8. Affidavit showed results for two compounds belonging to "cationic polymer". There is no data for silicones. The showing in the affidavit is not commensurate with the scope of claims (with respect to ingredients and also weight percent).
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO



MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/743,836

Page 9

Art Unit: 1615

**/JYOTHSNA A. VENKAT Ph. D/  
Primary Examiner, Art Unit 1615**